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### REMARKS

In the Office Action, the Examiner notes that claims 1-15 are pending in this Application and that claims 1-15 stand rejected. By this response, all claims continue unamended.

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, the Applicant believes that all of these claims are now in allowable form.

### REJECTIONS

#### **A. 35 U.S.C. §102**

The Examiner has rejected claims 1, 5 and 9-12 under 35 U.S.C. § 102(b) as being anticipated by Machemer et al. (U.S. Patent No. 5,510,173, issued April 30, 1996, hereinafter "Machemer"). The rejection is respectfully traversed.

The Examiner alleges that regarding claim 1, Machemer teaches a method for managing adjunct access for a circuit in a network management system, the method comprising the step of providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists. The Applicant respectfully disagrees.

The Applicant's invention, as defined in claim 1 (and similarly in claims 5, 9, and 12) recites:

"A method for managing adjunct access for a circuit in a network management system, the method comprising the step of:  
providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists." (emphasis added)

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"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). The Reed reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

In support of at least claim 1, the Applicant, in the specification, specifically recites:

"It should be noted that the present invention does not require a specific communication service type. Moreover, a specific type of service may not be requested by a customer, such as a customer merely seeking a circuit path from a point of origination to a point of destination. Therefore, those skilled in the art and informed by the teachings of the present invention will be readily able to adopt any appropriate service type for use with the present invention." (See Specification, page 4, lines 1-7).

"By connecting a first Portion A, a second Portion B and a final Portion N via links, a continuous managed circuit is provided allowing the circuit 100 to be identified in the IEC's network management system with one circuit identifier as opposed to a circuit identifier for each portion of the circuit. In addition, the automated design process works efficiently because circuit 100 is managed from first Portion A to final Portion N. Also, alarm monitoring for circuit 100 is complete because each portion of circuit 100 is managed because the links provide a continuous circuit." (See Specification, page 6, lines 14-21).

"Referring now to FIG. 2, a circuit between a source and destination has been provisioned via a first portion A, a second Portion B and a final Portion N. A bridge between the first Portion A and second Portion B is formed using an adjunct access portion 101, illustratively a Local Access Transport Area 102. That is, the managed portions (first portion A and second portion B) proximate the non-managed portion 101/102 are used to bridge the non-managed portion. It is noted that the non-managed portion may comprise an adjunct access area 101, a leased facilities portion 103, or other non-managed portion of a circuit. The invention operates to characterize the non-managed portion as a manageable network element such as a link, thereby enabling network management system control of all portions of the provisioned circuit." (See Specification, page 7, lines 4-15).

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As evident from the Applicant's disclosure (at least the sections provided above) and the Applicant's claims, the Applicant's invention is directed, at least in part, to providing a manageable link representing, in a network management system, each non-managed portion of a circuit in response to a determination that a non-managed portion of the circuit exists, wherein the present invention does not require a specific communication service type. As illustrated in the Applicant's specification, by connecting a first portion, a second portion, and a final portion of a circuit via respective, representative links, a continuous managed circuit is provided allowing the circuit to be identified in a network management system with one circuit identifier as opposed to a circuit identifier for each portion of the circuit. To further clarify the invention of at least claim 1, the Applicant, in the specification, specifically recites:

"It is noted that the sixth link  $LNK_F$  spans an adjunct access area portion 101 between the first Portion A and second Portion B of the circuit. Since, in the embodiment of FIG. 1, the adjunct access area portion 101 is under the control of a local exchange carrier (LEC), the LEC provides its own equipment to bridge between the first Portion A and second Portion B of the circuit. However, the adjunct access area portion 101 is considered non-managed by the interexchange carriers (IEC) network management system since the IEC network management system has no knowledge of the equipment used by the LEC to connect the first Portion A to the second Portion B of the circuit. Thus, by using a sixth link  $LNK_F$  to connect the first Portion A to the second Portion B of the circuit, the IEC has made a non-managed portion of the circuit become a managed entity within the IEC's Network Management System. (See Specification, page 5, lines 12-21).

Specifically in the extract of the disclosure cited above, the Applicant further clarifies how a non-managed portion of a circuit is reconfigured in a network management system to be considered a managed entity by the network management system.

In contrast to the invention of the Applicant, Machemer does not teach, suggest or disclose "providing a respective manageable link representing each

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non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists" as taught by the Applicant's specification and claimed in at least the Applicant's claim 1. In particular, the Machemer reference discloses "a data link access unit for insertion into a T1 span supporting the extended superframe (ESF) format", wherein the data link access unit "includes an interface for accessing the frames of digital data carried by the T1 span in ESF format (including the data link bits) and calculating performance monitoring data for the T1 span." (See Machemer, Abstract). In Machemer, a data link access unit is inserted in a T1 span for interfacing a non-ESF compatible unit with an ESF compatible unit. The data link access unit of Machemer includes a framer that converts frames of data from SF format to ESF format. In addition, the data link access unit in Machemer includes an interface for accessing the frames of digital data carried by the T1 span in ESF format and calculating performance monitoring data for the T1 span. The invention of Machemer relies on inserting an additional component in a circuit for interfacing units having non-ESF formats with units having ESF formats and for providing performance monitoring capabilities using the ESF information. As such, because of the addition of the data link access unit a circuit must be redesigned to accept this additional component taught in Machemer which may introduce additional sources of noise and other detrimental factors to a circuit. The Applicant's submit that the addition of an additional component in a T1 span for interfacing units having non-ESF formats with units having ESF formats and for providing provisioning information does not anticipate "providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists" as taught in claimed by the Applicant's invention. In contrast, the invention of the Applicant does not rely on adding additional components to a circuit. In the invention of the Applicant, a non-managed portion of a circuit is represented by a manageable link in a network management system, thereby enabling network management system control of all portions of the provisioned circuit (without the

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need to add additional components). The teachings of Machemer for the addition of a data link access unit do not anticipate the providing of a manageable link representing each non-manageable link in a network management system as taught and claimed in the Applicant's invention.

The Applicant respectfully submits that Machemer fails to teach each and every element of the Applicant's claimed invention. Machemer fails to teach "providing a manageable link representing each non-managed portion of the circuit" as claimed in at least the Applicant's claim 1. More specifically, the teaching of Machemer for the insertion of a data link access unit into a T1 span does not anticipate the Applicant's invention for providing a manageable link for each non-managed portion of a circuit, such that each non-managed portion of a circuit is depicted in a network management system as a managed entity. Nowhere in the Machemer reference is there any teaching, suggestion or disclosure for **providing a manageable link representing each non-managed portion of the circuit** as taught by the Applicant's specification and claimed in at least the Applicant's claim 1. Even further, Machemer fails to teach managing adjunct access for a circuit in a network management system wherein the network management system manages the entire circuit which includes the manageable link representing each non-managed portion of the circuit. As previously mentioned, the Machemer reference merely teaches inserting an additional component into a circuit, the additional component enabling interfacing of ESF and non-ESF components and enabling performance monitoring.

Additionally, the invention of Machemer requires a specific communication service type. That is, the invention of Machemer relies on ESF format for providing the performance monitoring in Machemer. In contrast, the invention of the Applicant does not require a specific communication service type.

Even further, there is absolutely no teaching, suggestion or disclosure in Machemer that a manageable link is provided for representing each non-managed portion of a circuit **"in response to a determination that a non-managed portion of the circuit exists"** as claimed in at least the Applicant's

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claim 1. The invention of Machemer does not teach determining that a non-managed portion of a circuit exists as taught in the Applicant's specification and claimed in at least the Applicant's claim 1. As such, for at least the reasons stated above, the Applicant respectfully submits that Machemer fails to teach each and every element of the claimed invention, as arranged in the claim, and as such fails to anticipate the invention of the Applicant.

Therefore, the Applicant submits that independent claim 1 is not anticipated by the teachings of Machemer and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Likewise, independent claims 5, 9 and 12 recite similar relevant features as recited in independent claim 1. As such, the Applicant submits that independent claims 5, 9 and 12 are also not anticipated by the teachings of Machemer and also fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

Furthermore, dependent claims 10-11 depend directly from independent claim 9 and recite additional features therefor. As such and for at least the reasons set forth herein, the Applicant submits that dependent claims 10-11 are also not anticipated by the teachings of Machemer. Therefore the Applicant submits that dependent claims 10-11 also fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims independently in subsequent prosecution.

**B. 35 U.S.C. §103**

The Examiner rejected claims 2-4, 6-8, and 13-15 under 35 U.S.C. §103(a) as being unpatentable over Machemer in view of Christie (U.S. Patent No. 6,201,812, issued March 13, 2001, hereinafter "Christie") and further in view of Owens et al. (U.S. Patent No. 6,415,150, issued July 2, 2002, hereinafter "Owens"). The rejection is respectfully traversed.

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Claims 2-4 depend from independent claim 1 and recite additional features thereof. For example, claim 2, when combined with independent claim 1, recites:

"A method for managing adjunct access for a circuit in a network management system, the method comprising the step of: providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists wherein each respective manageable link is coupled to at least one of a Digital Cross Connect (DCS), a Light wave Guided Cross Connects (LGX), and a Distribution Drop Point (DDP)." (emphasis added);

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

As discussed above, the Machemer reference merely discloses the addition of a data link interfacing unit to a T1 span to enable the interfacing of units having SF formats with units having ESF format and for using ESF format to provide performance monitoring. Nowhere in the Machemer reference is there any teaching or suggestion of "providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists." That is, as discussed above, the teachings of Machemer do not suggest, teach or describe the Applicant's invention at least with regard to the Applicant's claim 1. Therefore, at least because the teachings of Machemer do not suggest, teach or describe the invention of the Applicant regarding claim 1, the Applicant respectfully submits that the teachings of Machemer also do not teach, suggest, or describe the invention of the Applicant regarding dependent claims 2-4 and do not render the Applicant's claims 2-4 obvious.

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In addition, the Applicant respectfully submits that the teachings of Christie and Owens, alone, also do not suggest, teach or describe the Applicant's invention at least with regard to claim 1. In particular, the Christie reference merely discloses that digital cross connect (DCS) equipment may be utilized to connect the wiring from one network to another network (see Christie, column 2, lines 41-49). Moreover, the Owens reference merely discloses such DCS equipment may include LGX, DDP, Light span, among others (see Owens, column 6, lines 6-27, and column 8, lines 5-24). However, the Christie and Owens references fail to teach or suggest "providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists" as claimed in at least the Applicant's claim 1.

The Applicant further submits that there is no suggestion or motivation to combine the teachings of Machemer, Christie and Owens.

For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).



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The Applicant further submits that even if there was a motivation or suggestion to combine the references (which the Applicant believes that there is none), the teachings of the Christie and Owens references fail to bridge the substantial gap between the Machemer reference and the Applicant's invention at least with respect to claim 1. Again, the Christie reference merely discloses that digital cross connect (DCS) equipment may be utilized to connect the wiring from one network to another network (see Christie, column 2, lines 41-49). Moreover, the Owens reference merely discloses such DCS equipment may include LGX, DDP, Light span, among others (see Owens, column 6, lines 6-27, and column 8, lines 5-24). However, the Christie and Owens references fail to teach or suggest "providing a respective manageable link representing each non-managed portion of the circuit, responsive to a determination that a non-managed portion of the circuit exists" as recited in at least the Applicant's claim 1.

Again, even if the three references could somehow be operably combined, the combination of Machemer, Christie and Owens merely disclose a T1 span comprising a data link access unit for interfacing at least Digital Cross Connects, Light wave Guided Cross Connects or Distribution Drop Points. Thus, the three references fail to teach or suggest, either singularly or in combination, the Applicant's invention as a whole. That is, the combination of references fails to solve the problems in a manner as recited by the Applicant's claim 1. Specifically, the Applicant's invention allows a circuit having adjunct access and leased facility portions to be on one circuit such that the entire circuit may be managed by a Interexchange carrier (IEC) such as a long distance service provider. The combination of Machemer, Christie, and Owens simply do not teach, suggest or disclose at least a manageable link representing each non-managed portion of the circuit as taught and claimed by the Applicant's invention. Therefore, the combined references fail to teach the Applicant's invention as a whole at least with respect to the Applicant's claim 1.

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Therefore, at least because the teachings of Machemer, Christie and Owens, alone or in any allowable combination, do not teach, suggest, or describe the invention of the Applicant regarding at least claim 1 as discussed above, the Applicant respectfully submits that the teachings of Machemer, Christie and Owens, alone or in any allowable combination, also do not teach, suggest, or describe the invention of the Applicant regarding claims 2-4, which depend either directly or indirectly from independent claim 1, and do not render the Applicant's claims 2-4 obvious.

As such, the Applicant submits that claims 2-4, as they now stand, are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder.

Furthermore, dependent claims 6-8 and 13-15 respectfully depend from independent claims 5, 9, and 12, which recite similar limitations as recited in independent claim 1. As such, and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious with respect to the teachings of Machemer, Christie and Owens, alone or in any allowable combination. Therefore, the Applicant submits that all these dependent claims also fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder.

Therefore, the Applicant respectfully requests that the objections be withdrawn.

The Applicant reserves the right to establish the patentability of each of the claims independently in subsequent prosecution.

#### CONCLUSION

Thus, the Applicant submits that none of the claims presently in the application are anticipated under the provisions of 35 U.S.C. § 102 or obvious under the provisions of 35 U.S.C. § 103. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both

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reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Jorge Tony Villabon at (732) 530-9404 x1131 or Mr. Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,



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